

**REMARKS**

By this Amendment, Applicants amend claims 1 and 9 for clarity and without changing the scope thereof. Claims 1-20 are currently pending in this application.

In the Office Action mailed May 26, 2004, the Examiner rejected claims 1-4, 6-12, and 14-20 under 35 U.S.C. § 102(e) as anticipated by Tamano (U.S. Patent No. 6,032,157) and rejected claims 5 and 13 under 35 U.S.C. § 103(a) as unpatentable over Tamano in view of DeLorme et al. (U.S. Patent No. 5,848,373).

Applicants respectfully traverse the rejection of claims 1-4, 6-12, and 14-20 under 35 U.S.C. § 102(e) as anticipated by Tamano. To properly anticipate Applicants' claimed invention, the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2121 (8<sup>th</sup> ed., Aug. 2001), quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8<sup>th</sup> ed. Aug. 2001), p. 2100-69.

The Examiner has not met this burden. Applicants' claim 1 recites a method including, among other things, "displaying a raster map and a georeferenced map, wherein the raster map and the georeferenced map are separate maps," "identifying image coordinates associated with the first point on the raster map," "identifying geographic coordinates associated with the first point on the georeferenced map that correspond to the first point on the raster map," "identifying image coordinates associated with the second point on the raster map," "identifying geographic coordinates

associated with the second point on the georeferenced map; and determining a mathematical relationship between the image coordinates and the geographic coordinates."

The Examiner alleges that Tamano in Figs. 3-5 illustrates the elements of claim 1 and that Tamano, at col. 2, lines 40-66, discloses that image information linked with attribute information is first image (raster map) information, and image information that approximately positionally corresponds to the first image information is called second image (georeferenced map) information and is not linked to the attribute information. Applicants respectfully disagree.

Tamano discloses that image information linked with attribute information is referred to as first image information, and information that approximately corresponds to the first image information is referred to as second image information and is not linked to the attribute information. See col. 2, lines 41-52. An object contained in the second image information is used as a key, and the attribute information linked with the first image information is retrieved by inputting a correspondence between the second image information and the first image information via the key, i.e., by selecting an object in the second image information. See *id.* Thus, an object is selected in the second image information. The selected object is linked to the same object appearing in the first image information. The system then retrieves attribute information that is linked to the object in the first image information.

To link images, Tamano, as shown in Fig. 3, discloses a link information table 30, which contains object numbers of the first image information 1 in a column 31, and coordinates of the objects in the first image information 1 in a column 32. In addition,

object numbers of the second image information 2 are contained in a column 33, and coordinates of the objects in the second image information are contained in a column 34. The image numbers for first image information 1 are stored in the "IMAGE NO." column 31 and the "X, Y" coordinates are stored in column 32. Predetermined values are also stored in the "IMAGE NO." column 34 for second image information 2. See col. 5, lines 32-53. Therefore, Tamano discloses that a correspondence between objects of a first image and a second image is stored in link information table 30.

Tamano, however, does not disclose at least "displaying a raster map and a georeferenced map, wherein the raster map and the georeferenced map are separate maps," "identifying image coordinates associated with the first point on the raster map," "identifying geographic coordinates associated with the first point on the georeferenced map that correspond to the first point on the raster map," "identifying image coordinates associated with the second point on the raster map," "identifying geographic coordinates associated with the second point on the georeferenced map; and determining a mathematical relationship between the image coordinates and the geographic coordinates," as recited in claim 1.

Instead, Tamano discloses using predetermined relationships between objects of a first image and a second image. When an object on the second map is selected, the selected object is linked to the same object appearing in the first image. The system then retrieves attribute information that links the objects in the two images. Accordingly, the Examiner has not demonstrated that Tamano discloses all of the features of claim 1 and the Examiner should withdraw the rejection.

Additionally, Tamano does not disclose that the second image information is a georeferenced map, as the Examiner alleges. Tamano merely discloses that table 30 is made up of a column 31 that contains object numbers of the first image information 1, a column 32 that contains coordinates of the objects in the first image information 1, a column 33 which contains object numbers of the second image information 2, and a column 34 which contains coordinates of the objects in the second image information 2. See col. 5, lines 32-38.

Regarding this allegation, Applicants submit that it appears that the Examiner is taking Official Notice regarding the teachings of Tamano. Applicants respectfully refer the Examiner to the February 21, 2002 Memorandum from USPTO Deputy Commissioner for Patent Examination Policy, Stephen G. Kunin, regarding "Procedures for Relying on Facts Which are Not of Record as Common Knowledge or for Taking Official Notice." In relevant part, the Memorandum states, "If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding." Memorandum, p. 3. Applicants submit that the Examiner has made a generalized statement regarding Applicants' claims without any documentary evidence to support it. Applicants traverse the Examiner's presumed taking of "Official Notice," noting the impropriety of this action, as the Federal Circuit has "criticized the USPTO's reliance on 'basic knowledge' or 'common sense' to support an obviousness rejection, where there was no evidentiary support in the record for such a finding." *Id.* at 1. Applicants submit that "[d]eficiencies of the cited references cannot be remedied by ... general conclusions about what is 'basic knowledge' or 'common

sense.” In re Lee, 61 USPQ2d 1430, 1432-1433 (Fed. Cir. 2002), quoting In re Zurko, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Should the Examiner maintain the rejection after considering the arguments presented herein, Applicants submit that the Examiner must provide “the explicit basis on which the examiner regards the matter as subject to official notice and allow Applicants to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made” (*Id.* at 3, emphasis in original), or else withdraw the rejection. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claim 1, as well as the rejection of claims 2-8 and 17-18 based on at least their dependence upon allowable independent claim 1.

Similarly, independent claim 9 recites features generally corresponding to those of claim 1 and patentably distinguishes over Tamano for at least the same reasons as explained above regarding claim 1. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claim 9, as well as the rejection of claims 10-16 and 19-20 based on at least their respective dependence upon allowable claim and 9.

In addition, regarding claim 2, the Examiner alleges that the step recited in this claim is inherent “because Tamano in Figures 3-5 illustrate this step.” See Office Action, page 3. To properly anticipate claim 2, Tamano taken individually, must explicitly disclose each and every element recited in the claim. See M.P.E.P. § 2131 (8<sup>th</sup> ed. 2001). If Tamano, however, fails to expressly set forth a particular element, then the Examiner must show that this limitation is inherently disclosed to substantiate a claim of anticipation. See In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999). To establish inherency, the Examiner must specifically identify extrinsic evidence that

makes clear to one skilled in the art that the missing element “is necessarily present” in the Tamano disclosure. See *id.*; see also Continental Can Co. v. Monsanto. Co., 948 F.2d 1264, 1269 (Fed. Cir. 1991).

Nothing in Tamano discloses “using the mathematical relationship to determine the geographic coordinates of at least one feature on the raster map,” as recited in claim 2. The Examiner has merely stated that these features are inherent, citing only to Figures 3-5 without identifying any extrinsic evidence that makes it clear that these recitations are necessarily present in Tamano. Further, Figures 3-5 merely illustrate the methodology of Tamano, discussed above, for storing a correspondence between objects of a first image and a second image in link information table 30. Accordingly, the Examiner has not shown that Tamano teaches the features of claim 2 and should withdraw the rejection of claim 2 for at least this additional reason.

Regarding claim 8, the Examiner alleges that Tamano involves a two-dimensional coordinate system and has a response that is directly proportional to the input, which the Examiner alleges is considered as a general linear function. See Office Action, page 4. Again, the Examiner has made an unsupported allegation regarding Tamano and Applicants respectfully traverse this apparent taking of Official Notice. Nothing in Tamano discloses that “the mathematical relationship is represented by a set of general linear functions,” as recited in claim 8. The Examiner should thus withdraw the rejection of claim 8 for at least this additional reason.

Applicants respectfully traverse the rejection of claims 5 and 13 under 35 U.S.C. § 103(a) as unpatentable over Tamano in view of DeLorme et al. (U.S. Patent No. 5,848,373). To establish a proper *prima facie* case of obviousness under 35 U.S.C. §

103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8<sup>th</sup> ed. Aug. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8<sup>th</sup> ed. Aug. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8<sup>th</sup> ed. Aug. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8<sup>th</sup> ed. Aug. 2001).

Regarding claim 5, the Examiner admits that Tamano does not disclose that the geographic coordinates are latitude and longitude, but alleges DeLorme at col. 2, lines 25-35 makes up for this shortcoming of Tamano. First, DeLorme at col. 2, lines 25-35 does not disclose or suggest that the geographic coordinates are latitude and longitude. This passage merely states that the computer aided map location system (CMLS) disclosed by DeLorme provides "intelligent" printed maps by direct computer output of computer mapping and travel location data. Accordingly, the rejection is improper for at least this reason.

Second, even if DeLorme were to make up for the deficiencies of Tamamo, there is no suggestion or motivation to combine the teachings, as alleged by the Examiner. In particular, the Examiner alleges it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of DeLorme into Tamano to incorporate GPS technology that provides an improvement over a map

information that increases the efficiency of linking objects displayed on an image map to descriptive data. See Office Action, page 7. However, such a motivation is not relevant to the claim at issue, nor would one of skill in the art be motivated to combine Tamano with DeLorme.

Tamano, as discussed above, discloses storing predetermined correspondences between objects of a first image and a second image in link information table 30. On the other hand, DeLorme discloses providing correlation and coordination of spatially related data between a computer (PDA/PC/EC) and a set of printed maps typically printed on paper depicting surface features at desired levels of detail. See DeLorme, Abstract. Accordingly, there is no motivation arising from the references to combine Tamano's stand-alone system with that of DeLorme's disclosure of correlating printed maps with GPS data. Furthermore, the Examiner has not demonstrated a reasonable expectation of success for making the proposed combination.

Accordingly, for at least these reasons, the Examiner should withdraw the rejection of claim 5. In addition, because DeLorme does not make up for the deficiencies of Tamano discussed above, claim 5, which depends from allowable claim 1, is also allowable at least due to its dependence from an allowable claim.

The Examiner has applied the same rationale in rejecting claim 13. Accordingly, claim 13 is allowable for at least the reasons discussed above in relation to allowable claim 5.

**CONCLUSION**

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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